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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,673	03/24/2006	Masamichi Furukawa	0670-7072	5077
31780	7590	12/16/2009	EXAMINER	
ERIC ROBINSON			WILLIAMS, JEFFERY L.	
PMB 955			ART UNIT	
21010 SOUTHBANK ST.			PAPER NUMBER	
POTOMAC FALLS, VA 20165			2437	
			MAIL DATE	DELIVERY MODE
			12/16/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/573,673

Applicant(s)

FURUKAWA ET AL.

Examiner

JEFFERY WILLIAMS

Art Unit

2437

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 4, 17 - 20, and 22 - 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 17 - 20, and 22 - 25 is/are rejected.
- 7) ☒ Claim(s) 18 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the communication filed on 11/24/09.

Claims 1 – 4, 17 – 20, and 22 – 25 are pending.

All objections and rejections not set forth below have been withdrawn.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/09 has been entered.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claim 1 recites "digital watermark adding means for adding two kinds of digital watermark information". Claim 2 recites "digital watermark adding means for adding first digital watermark information".

Therefore, these features must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 18 and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, a claimed apparatus is limited by structure (i.e. defined by what it is) not how it is used. These claims essentially comprise descriptive recitations related to intended use and they fail to further limit the claimed apparatus.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 4, 17 - 20, and 22 - 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, and 17, it is noted that the applicant appears to suggest a particular distinction of broadcasted data via the recitation of “package media data or distribution data”, however, it is noted that such qualification of broadcasted data remains unexplained by the applicant and is not standard within the art. Thus, the examiner notes that the claims are unclearly recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 4, 17 – 20, and 22 – 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Morito et al. (Morito), U.S. Patent 6,310,956.

Regarding claim 1, Morito discloses:

A digital watermark information adding device having digital watermark information adding means for adding two kinds of digital watermark information to broadcast content data (Morito, 5:26-47; 7:55-8:6; Abstract; 5:5-8; fig. 5:23), wherein said two kinds of digital watermark information are first digital watermark information identifying whether the broadcast content data is package media data or distribution data and identifying whether the broadcast content data is recorded in a disk or a semiconductor memory and second digital watermark information having time information representing broadcasting time of said broadcast content data to be set and wherein the broadcasting time represented by the time information set in said second watermark information is utilized to judge whether or not a terminal receiving said broadcast content data should record the content data. Herein, Morito clearly discloses a device structure comprising a watermark adding means for adding two types of

watermark bits, thus Morito discloses means adding "digital watermark information identifying whether the broadcast content data is package media data or distribution data and identifying whether the broadcast content data is recorded in a disk or a semiconductor memory".

Regarding claim 2, it is rejected for the same reasons as claim 1, and furthermore because Morito discloses:

A digital watermark information adding device having digital watermark information adding means for adding first digital watermark information to broadcast content data (Morito, Abstract; 5:5-8; fig. 5:23; 5:26-47; 7:55-8:6), said first digital watermark information identifying whether the broadcast content data is package media data or distribution data and identifying whether the broadcast content data is recorded in a disk or a semiconductor memory, wherein said digital watermark information adding means further operates to add second digital watermark information having time information representing broadcasting time of said broadcast content data to be set to said broadcast content data, to allow a terminal receiving the broadcast content data which has been redistributed via a network.

Regarding claims 3 and 4, Morito discloses:

wherein said digital watermark information adding means adds digital watermark information (Morito, Abstract:3-12; fig. 5) representing that the broadcast content insists

the copyright to said broadcast content data, and wherein said digital watermark information adding means adds digital watermark information (Morito, Abstract:3-12; fig. 5) representing whether or not the broadcast content data is permitted to be distributed via a communication line.

Regarding claim 17, it is rejected for the same reasons as claims 1 and 2, and furthermore because Morito discloses:

input means for inputting content data to which two kinds of digital watermark information is added, said two kinds of digital watermark being first digital watermark information identifying whether the input content data is package media data or distribution data and identifying whether the broadcast content data is recorded in a disk or a semiconductor memory and second digital watermark information having time information representing recording or distributing time to be set (Morito, 5:26-47; 7:55-8:6; Abstract; 5:5-8; fig. 5:23);

time information identification means for identifying time information added to said input content data from said second digital watermark information (Morito, fig. 6:33);

clocking means for clocking the present time (Morito, fig. 6:34);

and recording means for recording said input content data in a recording medium and control means for causing the input content data to be recorded in said recording medium (Morito, fig. 6:30) if it is discriminated that the time information is added to said input content data, and the time information identified by said time information

identification means and the present time clocked by said clocking means are matched within a predetermined range.

Regarding claims 18 – 20, and 22 – 25, as best can be understood, Morito discloses:

wherein if it is discriminated that the time information is added to said input content data, and identified time information and the present time clocked by said clocking means are unmatched within a predetermined range, said control means operates to prohibit recording the input content data from being recorded in said recording medium (Morito, Abstract); copyright insistence information discrimination means for discriminating whether or not information representing the insistence of the copyright is added to said input content data, wherein if it is discriminated that the time information is not added to said input content data, and it is discriminated that the information representing the insistence of the copyright is added, recording the input content data in said recording medium is prohibited (Morito, Abstract; fig. 6:33); copyright insistence information discrimination means for discriminating whether or not information representing the insistence of the copyright is added to said input content data, wherein if it is discriminated that the time information is not added to said input content data, and it is discriminated that the information representing the insistence of the copyright is not added, the input content data is recorded in said recording medium (Morito, Abstract; fig. 6:33); wherein said control means operates to add information representing the insistence of the copyright as digital watermark information to said input content data;

wherein said clocking means is able to set the time clock at the time of manufacture of said data recording device (Morito, 6:58-60); wherein said clocking means clocks the year, month and day, and said time information includes only the year, month and day (Morito, 5:56-63; 7:1-12); wherein said clocking means imposes a restriction on the number of times the time clock can be set (7:21-36).

Response to Arguments

Applicant's arguments filed 4/20/09 have been fully considered but they are not persuasive.

Applicant argues essentially that:

Applicant respectfully submits that at least the portions of claims 18 and 22 that are underlined above further limit the claimed apparatus. Also, to the extent that claims 18 and 22 are considered to include functional recitations, the Examiner is reminded that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms," that "[f]unctional language does not, in and of itself, render a claim improper" and that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used" (MPEP § 2173.05(g)). The Applicant respectfully submits that dependent claims 18 and 22 further limit the claimed apparatus, and fairly convey to a person of ordinary skill in the pertinent art that the

control means must include additional functions beyond that which is recited in the respective independent claims. (Remarks, pg. 6,7)

Examiner responds:

The examiner respectfully maintains the objection for the reasons of record. The examiner reminds the applicant that a claimed apparatus is limited by structure (i.e. defined by what it is) not how it is used. "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Furthermore, it is noted that the claims are not objected to for using functional language as appears to be suggested by the applicant. Rather, it was pointed out that the claims were objected for comprising *only* functional language pertaining to the claimed apparatus. Thus, applicant clearly fails to further limit the claimed apparatus according to how an apparatus is to be defined according to patent law.

Applicant argues essentially that:

Specifically, independent claims 1 and 2 have been amended to recite identifying whether broadcast content data is package media data or distribution data and identifying whether the broadcast content data is recorded in a disk or a semiconductor memory. Independent claim 17 has been similarly amended ...

The Applicant respectfully submits that Morito does not teach the above-referenced features of the present invention, either explicitly or inherently. (Remarks, pg. 7, 8)

Examiner responds:

The examiner respectfully notes that the *significance* of the watermark bits added by a watermarking apparatus fails to distinguish the presently recited watermarking apparatus from the prior art watermarking apparatus. As the prior art fully discloses a structure capable of adding watermarking bits to a set of data, the examiner notes that the prior art discloses the claim limitations.

The examiner points out that the functional recitations added by amendment and the applicant's present arguments in accompaniment pertain largely to an *intended use* of a watermarking apparatus and for the function of identifying information. In light of such, the examiner respectfully suggests that the applicant may do well to treat such functional recitations within claims directed to a method as opposed to an apparatus. Thus, the applicant would allow the claims to be properly limited by function via the recitation of method steps.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See Notice of References Cited.

A shortened statutory period for reply is set to expire **3 months** (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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